

Patent 8  
PATENT  
395/35

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : GERARD M. HOUSEY  
SERIAL NO. : 09/510,562  
FILED : February 22, 2000  
FOR : METHOD FOR SCREENING FOR PROTEIN  
INHIBITORS AND ACTIVATORS  
GROUP ART UNIT : 1644  
EXAMINER : David A. Saunders

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ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. § 1.97(b)

SIR:

In conformance with Applicants' duty of disclosure under 37 C.F.R. § 1.56 (a) and § 1.97(b), the references listed on the attached form PTO-1449 are hereby brought to the Examiner's attention. In compliance with 37 C.F.R. § 1.98, a copy of the references are submitted herewith.

It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear in the "references cited" on any patent to issue therefrom.

Respectfully submitted,  
KENYON & KENYON

*Neil M. McCarthy*  
Neil M. McCarthy  
Reg. No. 43,435

Dated: August 16, 2000

KENYON & KENYON  
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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

P#4

**INFORMATION DISCLOSURE STATEMENT**

Docket Number:  
395/35

Application Number  
09/510,562

Filing Date  
February 22, 2000

Examiner  
D. Saunders

Art Unit  
1643

Invention Title  
**METHOD OF SCREENING FOR PROTEIN  
INHIBITORS AND ACTIVATORS**

Inventor(s)  
Gerard M. HOUSEY

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Address to:  
Assistant Commissioner for Patents  
Washington D.C. 20231

1. In accordance with the duty of disclosure under 37 C.F.R. § 1.56 and in conformance with the procedures of 37 C.F.R. §§ 1.97(c) and 1.98 and M.P.E.P. § 609, Applicant hereby brings the references listed on the attached modified PTO Form No. 1449 to the attention of the Examiner. It is respectfully requested that the references be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.
2. In accordance with 37 CFR § 1.98(d), copies of the references listed on the attached PTO Form 1449 which have been submitted in prior applications which are herein relied upon for an earlier filing date under 35 U.S.C. § 120 are not being resubmitted, but will be provided on request. A copy of each patent, publication or other information listed on the attached modified PTO Form 1449 which has not previously been submitted to the Patent Office in the prior applications is enclosed.
3. The following enclosed references (also listed on the PTO Form 1449) were cited by an opponent in the EPO Opposition Proceedings, or by an Examiner or by third parties during prosecution in the Japanese Patent Office:
  - ✓ (1) Jetten, A.M., et al., (1986) Mol. Cell. Biol. 6:3341-3348.
  - ✓ (2) Alberts, T. (1994) Molecular Biology of the Cell, 3rd ed., p. 1072.
  - (3) Japanese Unexamined Patent Publication No. 1-500964 [provided herewith as WO 88/03168 which is the English language equivalent].
  - ✓ (4) EP 327 369 A2
  - ✓ (5) Fukuda, K., et al., (1987) Nature 327:623-625.
  - ✓ (6) Takahashi, T., et al. (1985) J. Physiol. (Paris) 80:229-232.
4. In the parent application U.S. Ser No. 08/817,444, Applicant disclosed certain documents from the Opposition to EP 0 403 506 B1, which is the corresponding EP patent of this application. Applicant further provides copies and English translations of the following documents:
  - (1) Patentee's response of October 8, 1999 to communication according to Rule 71(a) EPC issued by the European Patent Office.

- (2) Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Hoechst AG (O1), October 7, 1999.
  - (3) English Translation of Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Hoechst AG (O1), October 7, 1999.
  - (4) Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Roche Diagnostics GmbH (O2), October 7, 1999.
  - (5) English Translation of Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Roche Diagnostics GmbH (O2), October 7, 1999.
  - (6) Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Boehringer Ingelheim GmbH (O3), November 15, 1999.
  - (7) English Translation of Brief in Opposition to EP 0 403 506 B1 filed in the European Patent Office by Boehringer Ingelheim GmbH (O3), November 15, 1999.
  - (8) Interlocutory Decision and marked copy of the disclosure and claims of EP 0 403 506 B1.
5. Pursuant to Interference No. 104,347, Applicant further includes:
- (1) Berman Preliminary Motion (3) with Appendices A-C and the accompanying Third Declaration of Anthony B. Chen, Ph.D. (Exhibit 2032).
  - (2) Housey Opposition to Berman Preliminary Motion (3) with Appendices A and B and the accompanying First Declaration of James D. Griffin, M.D. (Exhibit 1010).
  - (3) Berman Reply to Housey Opposition with Appendices 1-5 and accompanying Fourth Declaration of Anthony B. Chen, Ph.D. (Exhibit 2037).
6. Two U.S. Patent publications are provided herewith. They are: U.S. Patent 5,877,007 to Housey, which issued from U.S. Application Ser. No. 08/473,169 and which is not relied upon for an earlier filing date under 35 U.S.C. § 120; and U.S. Patent 4,981,790 to Haseltine et al., which is of record in the aforementioned application.
7. As a first office action on the merits has not been mailed in this application, no fee is believed due. However, should any such fees be due, the Commissioner is authorized to charge Deposit Account No. 11-0600 for such fees. A duplicate copy of this communication is enclosed.

Dated: July 11, 2000

By: Ned M. McCarthy Reg. No. 43,435  
*for* M. Lisa Wilson (Reg. No. 34,045)

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(212) 425-5288 (facsimile)

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

**INFORMATION DISCLOSURE  
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395/35

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Examiner  
D. Saunders

Art Unit  
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Invention Title  
METHOD OF SCREENING FOR PROTEIN  
INHIBITORS AND ACTIVATORS

Inventor(s)  
Gerard M. HOUSEY

Address to:  
Assistant Commissioner for Patents  
Washington D.C. 20231

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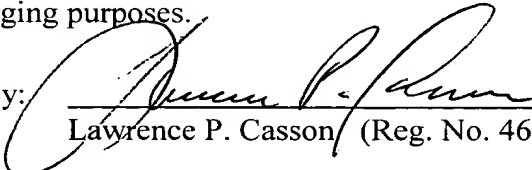
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SIR:

1. In accordance with the duty of disclosure under 37 C.F.R. § 1.56 and in conformance with the procedures of 37 C.F.R. §§ 1.97(c) and 1.98 and M.P.E.P. § 609, Applicant hereby brings the references listed on the attached modified PTO Form No. 1449 to the attention of the Examiner. It is respectfully requested that the references be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.
2. Consistent with the policy that we have followed throughout the prosecution, we bring to the attention of the Examiner the following reference which was recently brought to our attention:  
(1) Balzarini, J. et al. (1985) FEBS Lett. 185:95-100.
3. No item of information contained in this information disclosure statement (IDS) was cited in a communication from a foreign patent office in a counterpart foreign application, and to the knowledge of the undersigned after making reasonably inquiry, no item of information contained in this IDS was known to any individual designated in § 1.56(c) for than three months prior to filing of this IDS.
4. It is believed that no fees are due in connection with this Information Disclosure Statement. However, should any fees be due, the Commissioner is authorized to charge Deposit Account No. 11-0600 for such fees. A duplicate copy of this communication is enclosed for charging purposes.

Dated: April 24, 2001

By:

  
Lawrence P. Casson (Reg. No. 46,606)

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New York, N.Y. 10004  
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PATENT AND TRADEMARK OFFICE

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**INFORMATION DISCLOSURE  
STATEMENT**

Docket Number:  
395/35

Application Number  
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Filing Date  
February 22, 2000

Examiner  
D. Saunders

Art Unit  
1643

Invention Title  
METHOD OF SCREENING FOR PROTEIN  
INHIBITORS AND ACTIVATORS

Inventor(s)  
Gerard M. HOUSEY

Address to:  
Assistant Commissioner for Patents  
Washington D.C. 20231

SIR:

1. In accordance with the duty of disclosure under 37 C.F.R. § 1.56 and in conformance with the procedures of 37 C.F.R. §§ 1.97(c) and 1.98 and M.P.E.P. § 609, Applicant hereby brings the references listed on the attached modified PTO Form No. 1449 to the attention of the Examiner. It is respectfully requested that the references be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.
2. Consistent with the policy that we have followed throughout the prosecution, we bring to the attention of the Examiner the following references which were submitted to the Japanese Patent Office by anonymous third parties and which were recently brought to our attention:
  - (1) Noguchi, S. et al. (1987) FEBS Lett. 225:27-32.
  - (2) Sandstrom, E.G. et al. (1985) Lancet 1(8444):1480-1482.
  - (3) Umbach, J.A. et al. (1987) Proc. Natl. Acad. Sci. USA 84:5464-5468.
  - (4) von Meyenburg, K. et al. (1985) EMBO J. 4:2357-2363.
3. The Commissioner is hereby authorized to charge payment of the \$ 180.00 fee due under 37 C.F.R. §1.17(p) for submission of an information disclosure statement under §1.97(c), as well as any additional fees that may be associated with this submission, to Deposit Account No. 11-0600 (Kenyon & Kenyon). A duplicate copy of this sheet is enclosed for charging purposes.

Dated: April 17, 2001

By:

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Lawrence P. Casson (Reg. No. 46,606)

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